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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,011	11/10/2003	Vladimir Mordekhay		6211
7590	10/08/2004			
Vladimir Mordekhay c/o V. Balter 1045 Lassen Drive Menlo Park, CA 94025			EXAMINER LEVKOVICH, NATALIA A	
			ART UNIT 1743	PAPER NUMBER

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/706,011	MORDEKHAY, VLADIMIR
	Examiner Natalia Levkovich	Art Unit 1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11/10/2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) 11,14 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The information disclosure statement (IDS) submitted on 11/10/2003 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Objections

2. Claim 11 is objected to under 37 CFR 1.75 as being a duplicate of claim 9. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).
3. Claim 14 is objected since it refers to the next claim 15.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Nova et al. (USP 6, 329, 139).

Nova teaches an automated system for “matrix materials with programmable data storage or recording devices or other memory means” (col.4, line 60). “The matrices may be in the form of... a test tube or microplate, 96 well or 384 well or higher density formats or other such microplates and microtiter plates. The matrices may contain one or a plurality of recording devices”..., a memory device may be embedded into matrices (col. 7, line 5) by various means including , for instance, being “mounted within well ... by adhesive or other bonding process, or may be press fit into the well” (col.58, line30).“In other embodiments, the memory is part of the container that contains the sample or is part of the instrument. ” (col.15, line 5).

“The matrices with memories are used in assays, such as scintillation proximity assays [SPA], FP [fluorescence polarization] assays, FET [fluorescent energy transfer] assays, FRET [fluorescent resonance energy transfer] assays and HTRF [homogeneous time-resolved fluorescence] assays, the matrices may be coated with, embedded with or otherwise combined with or in contact with assay material, such as scintillant, fluophore or other fluorescent label” (col.7, lines 55-60).

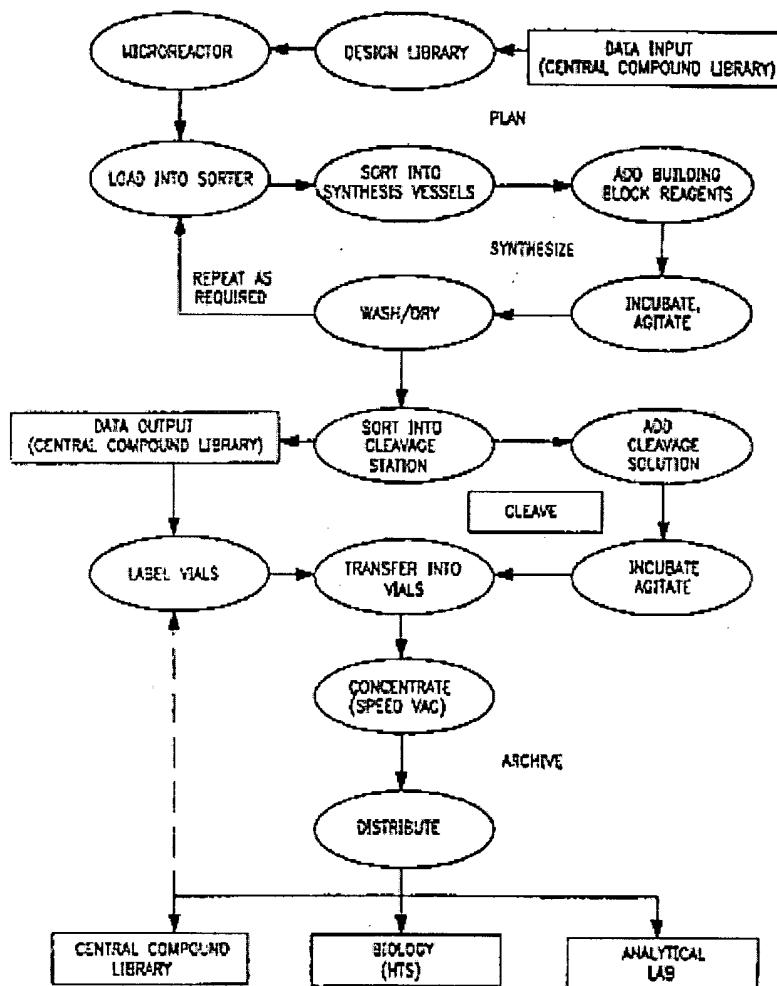
“The recording device ... includes at least one data storage unit that includes a remotely programmable and remotely readable, preferably non-volatile, memory” (col.8, line5)”.

“These memory devices include dynamic random access memories [DRAMS, which refer to semiconductor volatile memory devices that allow random input/output of stored information” (col.13, line 35).

“The memories may be pre-encoded or may be encodable during, after or before processing “(col.5, line 25).“Programming and reading the memory (“data input/output”-N.L.) is effected remotely, preferably electromagnetic radiation, particularly radio frequency [RF] or radar, microwave, or microwave or energies between RF and microwave, or by reading the imprinted information” (col.5, line 45).

“Automated sorting devices, systems using the devices and methods of sorting are also provided herein. In one embodiment, for example, a sorting device that is fully automated to load, read from and write to the matrix with memory device, and automatically place the matrix with memory device in the properly selected location of the sorting device is provided. Exemplary software for use with the sorter is also provided”(col.20, lines 5-10, Fig. 75a).

FIG. 75a



"The system controller receives the data signal and associates the information therein with a corresponding synthesis sequence of the plurality of synthesis sequences to determine a next step within the synthesis sequence, identifies the pre-determined synthesis container corresponding to the next step within the synthesis sequence, generates the positioning signal for moving the positioning means to the pre-determined synthesis container, and generates the release signal for releasing the matrix-with-memory from the positioning means

into the pre-determined synthesis container"(col.198, lines 10-15).

One of the preferred embodiments of the invention "is the fully automated and communicating laboratory in which all aspects of synthesis and screening are automated and/or communicated from one container or instrument to another, thereby tracking and following the synthesis, screening and storage and subsequent use of compounds synthesized on matrices with memories as provided herein" (col.21, lines 10-15).

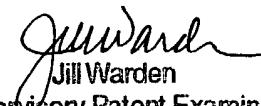
Conclusion

All the claims are rejected.

.Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalia Levkovich whose telephone number is 571-272-2462. The examiner can normally be reached on Mon-Fri, 8 a.m.-4p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jill Warden
Supervisory Patent Examiner
Technology Center 1700